

REMARKS

The present application has been reviewed in light of the non-final Office Action dated May 13, 2009.

Status of Claims

Claims 23-27, 29-32 and 34-39, as filed in the communication dated June 25, 2008, are pending in the present application. Claims 23, 29, 35 and 37-39 are in independent form. Claims 1-22, 28 and 33 were previously cancelled.

By this Amendment, claims 23-27, 30-32, 34 and 36 have been amended. Applicant respectfully submits that no new matter has been introduced into the disclosure by way of the present amendments to claims 23-27, 30-32, 34 and 36.

Entry of this Amendment is respectfully requested.

Objection to Claims

In the May 13, 2009 Office Action, the Examiner objected to dependent claims 24-27, 30-32, 34 and 36 as having informalities.

The preamble of dependent claims 24-27, 30-32, 34 and 36 presently recite "A clip manipulating device according to...". The Examiner suggested that the preamble of claims 24-27, 30-32, 34 and 36 should be amended to recite "The clip manipulating device according to...".

By this Amendment, claims 24-27, 30-32, 34 and 36 have been amended in accordance with the Examiner's suggestion.

Withdrawal of the Examiner's objection to claims 24-27, 30-32, 34 and 36 is respectfully requested.

Rejection of Claims – 35 U.S.C. §103(a)

In the May 13, 2009 Office Action, the Examiner rejected claims 23-27, 29-32 and 34-39 under 35 U.S.C. §103(a). The Examiner rejected claims 23-26, 29-32, 34, 35 and 37-39 as being allegedly unpatentable over U.S. Patent No. 7,011,667 to Kobayashi et al. (hereinafter “Kobayashi”) in view of U.S. Patent No. 6,352,503 to Matsui et al. (hereinafter “Matsui”). The Examiner rejected claims 27 and 36 as being allegedly unpatentable over Kobayashi in view of Matsui and U.S. Patent No. 5,766,184 to Matsuno et al. (hereinafter “Matsuno”).

By this Amendment, independent claim 23 has been amended to clarify certain features of the claimed clip manipulating device. Specifically, claim 23 has been amended to recite in clean copy:

A clip manipulating device comprising:

a flexible insertion tube capable of being inserted into a cavity of a living body and having a curved portion at a distal end portion;

a flexible wire having pliability and movable through the insertion tube;

a junction provided on a distal end portion of the wire, detachably coupled with a clip located at the distal end portion of the insertion tube for effecting grasping operation and disengaging operation of the clip,

wherein the junction is pliable enough to follow substantial bending deformation of the insertion tube, such that movement in the tube is not hindered by the bending deformation, and the junction includes a looped flexible wire of a predetermined length, one end of which is coupled with the clip and a coupling member connected to the flexible wire, the coupling member has a deformable portion coupling with the other end of the looped flexible wire, the deformable portion being deformable to release the looped flexible wire, and the looped flexible wire having a length between the clip and the deformable member such that when one end of the looped flexible wire engaged with the clip is released from the distal end portion of the flexible insertion tube, the coupling member does not enter the curved portion of the flexible insertion tube.

Applicant respectfully traverses the Examiner's rejection of claims 23-27, 29-32 and 34-39 for at least the following reasons.

First, Applicant respectfully submits that Kobayashi is disqualified as a prior art reference under 35 U.S.C. §103(c).

Under 35 U.S.C. §103(c), subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. §102, shall not preclude patentability under 35 U.S.C. §103 where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

U.S. Patent No. 7,011,667 is the primary reference in the above-listed 35 U.S.C. §103(a) rejection of claims 23-27, 29-32 and 34-39. U.S. Patent No. 7,011,667 was issued March 14, 2006 to Tsukasa Kobayashi, Junichi Muramatsu, Takayuki Suzuki, and Hideki Shimonaka. As recorded at Reel 012844, Frame 0348 and Reel 015889, Frame 0604, the assignee of U.S. Patent No. 7,011,667 is Olympus Corporation. Specifically, U.S. Patent No. 7,011,667 was assigned to Olympus Optical Co., Ltd., as recorded at Reel 012844, Frame 0348, and the assignee's name (Olympus Optical Co., Ltd.) was then changed to Olympus Corporation, as recorded at Reel 015889, Frame 0604.

The present application, filed March 18, 2004 and listing Tsutomu Okada as the sole inventor, is a continuation of International Application No. PCT/JP03/09048, filed July 16, 2003. The present application was assigned to Olympus Corporation, as recorded at Reel 015121, Frame 0236.

Accordingly, since both the March 18, 2004 filing date of the present application and the July 16, 2003 filing date of International Application No. PCT/JP03/09048 predate the

March 14, 2006 issue date of U.S. Patent No. 7,011,667, U.S. Patent No. 7,011,667 is cited only as a reference under 35 U.S.C. §102(e), and as a commonly owned patent “shall not preclude patentability” under 35 U.S.C. §103.

Second, Applicant respectfully submits that having disqualified Kobayashi as a prior art reference, the combined teachings of the remaining cited references (Matsui and Matsuno), do not render the claimed subject matter of the pending claims obvious.

For the above-stated reasons, Applicant respectfully submits that claims 23-27, 29-32 and 34-39 are patentable over the cited references.

Withdrawal of the Examiner’s rejection of claims 23-27, 29-32 and 34-39 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant’s attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

/Thomas Spinelli/

Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
TS/WC:cm